

REMARKS

Claims 3-18, 25-27, 30-31 and 39-49 are pending in the Application. Claims 3-18, 25-27, 30-31 and 39-49 stand rejected. In addition to the amendments discussed below, Applicants have amended the currently pending claims for clarification purposes. Applicant respectfully requests consideration of the newly presented claims and their allowance.

Interview

Applicants' undersigned attorney wishes to thank Examiner Chen for the opportunity, on July 28, 2009 and August 4, 2009, to conduct telephonic interviews regarding the pending Application. During the interviews, the cited art, specification, and Applicants' proposed amendments were discussed. Although no agreement was reached, potential avenues for advancing prosecution were discussed. Should the examiner have any questions or concerns that might be efficiently resolved by way of a telephonic interview, the examiner is invited to call Applicants' undersigned attorney at 206-903-2474.

Claim Rejections - 35 USC § 101

Claim 51 stands rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter. Specifically, the Examiner contends that the body of the claim lacks a physical device such as a computer or machine to execute the claimed means plus function steps. Applicants respectfully traverse the rejection.

Applicants respectfully submit that claim 51 properly recites "means or step plus function" in accordance with 35 USC §112 sixth paragraph and MPEP 2181. As noted in MPEP 2181 II, "a claim limitation expressed in means-plus-function language 'shall be construed to cover the corresponding structure described in the specification and equivalents thereof.'" Furthermore, Applicants submit that the corresponding structure is disclosed in the specification in a way that one skilled in the art will understand what structure will perform the recited function. For example, paragraphs 0136 to 0140 describe various embodiments in which the described claim functions can be carried out. Accordingly, Applicants request withdrawal of the 35 U.S.C. § 101 rejection.

Claim Rejections - 35 USC § 102

Claims 3-18, 25-27, 30-31 and 39-49 stand rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 5,948,040 issued to DeLorme et al. (hereinafter referred as DeLorme). Applicants respectfully request withdrawal of the rejections in view of the following remarks. Applicants further reserve the right to antedate DeLorme in a future communication.

The standard under Section 102 is one of strict identity. “Under 35 U.S.C. § 102, every limitation of a claim must identically appear in a single prior art reference for it to anticipate the claim” (*Gechter v. Davidson*, 116 F.3d 1454, 1457 (Fed. Cir. 1997)). In addition, “[e]very element of the claimed invention must be literally present, arranged as in the claim” (*Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989)). Further, implicit in a review of an examiner’s anticipation analysis is that the claim must first have been correctly construed to define the scope and meaning of each contested limitation (*Gechter v. Davidson*, 116 F.3d 1454, 1457 (Fed. Cir. 1997); *In re Paulsen*, 30 F.3d 1475, (Fed. Cir. 1994), stating for example, “to properly compare [an allegedly anticipatory prior art reference] with the claims at issue, we must construe the term ‘computer’ to ascertain its scope and meaning.”).

In the Office Action page 4, the Examiner contends that “said search result sufficient to enable said user client to instantiate an image including one or more representations based on said subset superimposed over a map image of a geographic area represented by said geographical map data and render navigable areas within said geographical area without requiring new map data to be provided to the user client” is disclosed by DeLorme Figures 1B, 1C, 8 and 9 and associated texts, in particular col. 24, line 29 - col. 26, line 28. Applicants respectfully disagree. The cited passages variously describe a capability to zoom to different scale maps with variable resolution or levels of detail and to pan or shift to other map locations. Applicants’ representative has reviewed the passages and does not find that the claimed “render navigable areas within said geographical area without requiring new map data to be provided to the user client” is disclosed. While a capability to zoom on a map display may imply that the zoomed areas can be rendered without downloading additional data, drawing such implications is

improper in a 35 USC § 102 rejection. As set forth above, the standard of anticipation is one of strict identity. Thus, a reference that may describe something considered to be “implied” to the claimed subject matter is not an anticipation. Furthermore, Applicants respectfully submit that downloading additional map data is not inherent per MPEP 2131.01 (III). Applicants thus request that the 35 USC § 102 rejection be withdrawn.

Without conceding the propriety of the rejection, Applicants have amended claim 3 to recite: “the search result comprising a subset of said data pertaining to the commercial enterprises *and said geographical map data, wherein the subset of geographical map data is optimized into one or more minimal-sorted groups and compressed into data packets, the data packets comprising information for restoring said subset of geographical map data,*” (emphasis added). Support for the amendments may be found at least in paragraphs 0087 to 0107 of the specification. Applicants respectfully submit that DeLorme does not disclose or suggest claim 3 as amended and is allowable.

The Examiner has rejected independent claims 30, 41, 46, 48, 50, and 51, allegedly as being anticipated by DeLorme. These claims recite similar features as claim 3, and for at least the grounds argued above with respect to independent claim 3, DeLorme does not anticipate claims 30, 41, 46, 48, 50, and 51. Furthermore, Applicants have amended claims 30, 41, 46, 48, 50, and 51 to recite similar features as claim 3 and submit that DeLorme does not disclose or suggest claims 30, 41, 46, 48, 50, and 51 as amended. Thus, Applicants respectfully request withdrawal of the rejection of claims 30, 41, 46, 48, 50, and 51. Applicants submit that dependent claims 4-18, 25-27, 31, 39-40, 42-45, 47, and 49 are allowable at least by virtue of their dependency on an allowable base claim.

Conclusion

Applicant respectfully submits that the pending claims patentably define over the cited art and respectfully requests reconsideration of all pending claims. Should the examiner have any

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further suggestions for expediting the prosecution of the presently pending claims, the undersigned respectfully asks the examiner contact him at **206-903-1474**.

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